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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,711	10/10/2000	Pallab K. Chatterjee	020431.0706	4657
7590	03/18/2004		EXAMINER	
Baker Botts LLP 2001 Ross Avenue Dallas, TX 75201-2980			CHENCINSKI, SIEGFRIED E	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/686,711	CHATTERJEE ET AL.	
<b>Examiner</b>	<b>Art Unit</b>	<i>Mly</i>	
	Siegfried E. Chencinski	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 10 October 2000.  
2a)  This action is **FINAL**.                    2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-36 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## DETAILED ACTION

### 1. MINOR INFORMALITIES

#### a) *Specification*

The specification contains typographical errors. The errors are located at:

- Page 2, line 14, "shipping the goods to the "seller". The context suggests that the word "seller" should be the word "buyer".

Correction is required.

#### b) *Claims*

- Claims 29 and claim 34 appear to have the same word error as in the specification. The claims sequence suggests that the word "seller" should be the word "buyer" in each of these claims. These two claims are identical as they stand. The claims are being interpreted on the basis of this change.

Correction is required.

## ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**2. Claims 1 – 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Shavit et al. (US Patent 4,799,156).**

**Re. Claims 1, 13 & 25,** Shavit anticipates a computer-implemented marketplace, method and system for providing one or more financial transaction services to participants in connection with commercial transactions involving the participants, comprising:

- a database containing (Col. 2, lines 25-27);
- registration information for one or more types of transactions available to participants through the marketplace (subscription/registration – Col. 6, lines 4-6; transactions available/options – Col. 6, lines 29-31);
- participation criteria for each participant specifying one or more types of transactions in which the participant is willing to participate in association with the marketplace (Fig. 2; Col. 6, lines 4-9); and
- one or more processes each operable to provide an associated financial transaction service for one or more participants in connection with ongoing transactions involving the participants (Fig.'s 2, 16, 22, 27-30; Col. 8, line 23 – Col. 9, line 42);
- the marketplace operable to initiate a selected process in response to a specified event associated with an ongoing transaction, according to the registration information and participation criteria, to provide a corresponding financial transaction service to at least one participant involved in the ongoing transaction (Fig.'s 2, 16, 22, 27-30; Col. 8, line 23 – Col. 9, line 42).

**Re. Claims 2 & 14,** Shavit anticipates a marketplace of Claim 1, wherein at least some of the registration information comprises a time limit for a transaction or one or more aspects thereof (Urgent Shipment - Col. 6, l. 55; late shipment - Col. 10, l. 36).

**Re. Claims 3 & 15,** Shavit anticipates a marketplace of Claim 1, wherein at least some of the registration information comprises a payment point, the marketplace operable to generate payment instructions for communication to a participant in response to a

transaction reaching the payment point (Fig.'s 14 (344), 15 (354), 16 (390); Col. 8, ll. 55-64).

**Re. Claims 4 & 16**, Shavit anticipates a marketplace of Claim 1, wherein at least some of the participation criteria is selected from the group consisting of item type information, value information, and delivery information (Col. 5, l. 65 – Col. 6, l. 51).

**Re. Claims 5 & 17**, Shavit anticipates a marketplace of Claim 1, wherein the participation criteria for at least one participant comprise default criteria specifying all types of transactions (Col. 5, l. 65 – Col. 6, l. 51).

**Re. Claims 6 & 18**, Shavit anticipates a marketplace of Claim 1, wherein the initiated process comprises at least one associated person to assist in providing the corresponding service (Col. 5, l. 34).

**Re. Claims 7 & 19**, Shavit anticipates a marketplace of Claim 1, wherein the specified event comprises the initiation of the associated commercial transaction (Col. 6, ll. 19-25, 34, 37-38).

**Re. Claims 8 & 20**, Shavit anticipates a marketplace of Claim 1, wherein the initiated process is operable to initiate a transfer of funds on behalf of the participant (Col. 8, l. 55 – Col. 9, l. 6).

**Re. Claims 9 & 21**, Shavit anticipates a marketplace of Claim 8, wherein the transfer of funds is made by a financial agent of the participant to a financial agent of a second participant through the marketplace (Col. 8, l. 65 – Col. 9, l. 19; among some agent to agent combinations are bank to bank, lender to bank, or bank to factor,).

**Re. Claims 10 & 22**, Shavit anticipates a marketplace of Claim 8, wherein the initiated process is operable to generate information for communication to one or more enterprise resource planning (ERP) systems associated with the participant (Col. 1, ll. 5-12; Col. 1, l. 24 –Col. 2, l. 5. ERP systems are computer software systems which link purchasing/materials, accounting and manufacturing. The user systems anticipated by Shavit are the enterprise systems which existed in the middle 1980's and which have grown in sophistication since then. The ASK Manman ERP system was one of the leading old enterprise systems which was then supplanted in the middle 1990's by ERP systems provided by SAS, Baan, Oracle and others).

**Re. Claims 11 & 23**, Shavit anticipates a marketplace of Claim 1, wherein at least one of the processes is a participant qualification process operable to determine the acceptability of the participant and of one or more financial agents:

- from which the participant may select (Col. 5, l. 66 – Col. 6, l. 51; Col. 8, l. 55 – Col. 9, l.6); and
- from or to which funds may be transferred on behalf of the participant (Col. 5, l. 66 – Col. 6, l. 51; Col. 8, l. 55 – Col. 9, l.6).

**Re. Claims 12 & 24**, Shavit anticipates a marketplace of Claim 11, further operable to monitor the activities of the participant during the ongoing transaction for purposes of assessing the qualification of the participant (Col. 14, ll. 50-62).

**Re. Claims 26, 31 & 36**, Shavit anticipates software and a method operating at a computer-implemented marketplace for settling a commercial transaction between a buyer and a seller, the software being embodied in a computer-readable medium and operable to:

- receive an order for at least one item from the buyer (Col. 1, l. 35; Col. 6, l. 34; Col. 15, ll. 7-13);
- communicate the order to the seller for fulfillment of the order (Col. 2, ll. 21-26; Col. 5, ll. 39-50; Col. 7, ll. 1-5; Col. 8, ll. 12-15);
- receive notification from the seller in response to shipping of the item (Col. 11, ll. 11-21, 55);
- receive notification from the buyer in response to acceptance of the item (Col. 9, ll. 26-27);
- communicate payment instructions to at least one financial agent associated with the buyer (Col. 8, ll. 55-58);
- receive payment from the financial agent associated with the buyer (Col. 8, l. 55 – Col. 9, l. 19);
- communicate the payment to a financial agent associated with the seller (Col. 8, ll. 55-58);

- receive notification from the seller in response to acceptance of the payment (Fig. 15 - managing payee's and payer's statement info.; Fig. 16 – statements and reports); and
- communicate accounting information reflecting settlement of the transaction (Fig. 16 – statements and reports).

**Re. Claims 27 & 32,** Shavit anticipates software of Claim 26, further operable to communicate the order to a financial agent associated with the buyer or the seller (Fig. 2; Col. 5, l. 66 – Col. 6, l. 18; Col. 8, ll. 23 – 41, 55-58).

**Re. Claims 28 & 33,** Shavit anticipates software of Claim 26, wherein the financial agent associated with the buyer is integral to the buyer (Inherent, e.g. when the buyer is a financial institution).

**Re. Claims 29 & 34,** Shavit anticipates software of Claim 26, wherein the financial agent associated with the buyer is integral to the seller (Inherent, e.g. when the seller is a financial institution).

**Re. Claims 30 & 35,** Shavit anticipates software of Claim 26, further operable to communicate the accounting information to enterprise resource planning (ERP) functionality associated with the buyer or the seller (Supra. See claims 10 & 22).

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703- 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks Washington D.C. 20231*

or faxed to:

Art Unit: 3628

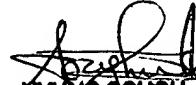
(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-9601 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2411 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC

March 11, 2004

  
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